

REMARKS

The Office Action dated April 23, 2004 has been received and carefully noted. The above amendments to the claims, and the following remarks, are submitted as a full and complete response thereto.

Claims 1, 12, 16 and 18 have been amended to more particularly point out and distinctly claim the subject matter of the invention. No new matter has been added, and no new issues are raised which require further consideration and/or search. Claims 1-7, 10-12, 16, 18-24, 27-29 and 33 are respectfully submitted for consideration.

The Office Action objected to claims 12 and 16 because of alleged minor informalities. Claim 16 was objected to because the limitation "said requested" was recited instead of "said request." Claim 12 was objected to because of the use of "in conjunction with." Applicants have amended both claims to address the objections and respectfully asserts that those rejections should now be withdrawn as being moot.

The Office Action rejected claims 1, 3, 10, 11, 18, 19, 27 and 28 under 35 U.S.C. § 102(b) as being anticipated by *Gore et al.* (U.S. Patent No. 5,313,463). Applicants note that the preamble of the rejection recites claim 19 but the body of the rejection refers to claim 20. The Office Action also rejected claims 2, 4, 19 and 21 under 35 U.S.C. § 103(a) as being unpatentable over *Gore et al.* in view of *Wrede et al.* (U.S. Patent No. 5,937,040). Claims 5 and 22 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Gore et al.* in view of the *European Telecommunication Standards Institute Reference* (February 1996). Claims 6 and 23 were rejected under 35 U.S.C. §

103(a) as being unpatentable over *Gore et al.* in view of the *European Telecommunication Standards Institute Reference* (October 1991). Claims 7 and 24 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Gore et al.* in view of *Newton's Telecom Dictionary* (March 1998). Claims 12 and 29 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Gore et al.* in view of *Masuda* (U.S. Patent No. 4,709,387). The above rejections are respectfully traversed based on the remarks that follow.

Applicants note that claims 12 and 16 were not rejected over prior art and the Office Action Summary provides that those claims are objected to. While there is no explicit indication that those claims contain allowable subject matter, it appears that the Office Action intended to so indicate. Clarification by the Examiner in the next communication is respectfully requested.

The present invention is directed, according to claim 1, to a method for providing telephone book information in a digital multiple-service network. The network includes an exchange, a calling subscriber telecommunication terminal connected to the digital multiple-service network via a first ISDN interface, and a called subscriber telecommunication terminal connected to the network via a second ISDN interface. The method includes requesting calling subscriber telephone book information by sending from the called subscriber telecommunication terminal to the exchange a message requesting the calling subscriber telephone book information and comprising the number of the calling subscriber, the request being initiated by the called subscriber, in response

to the received message, sending a query for the calling subscriber telephone book information from the exchange to a server implementing a telephone book information service, the server being connected to the multiple-service network via a third ISDN interface, in response to the received query, sending the calling subscriber telephone book information from the server to the exchange and in response to the received calling subscriber telephone book information, sending the calling subscriber telephone book information from the exchange to the called subscriber telecommunication terminal using channels reserved for signaling and a signaling protocol comprising a limited amount of information not belonging to the call.

The present invention is also directed, according to claim 18, to a system for providing telephone book information in a digital multiple-service network. The network includes an exchange, a calling subscriber telecommunication terminal connected to the digital multiple-service network via a first ISDN interface, and a called subscriber telecommunication terminal connected to the network via a second ISDN interface. The system includes requesting means for requesting calling subscriber telephone book information by sending, from the called subscriber telecommunication terminal to the exchange, a message requesting the calling subscriber telephone book information and comprising the number of a calling subscriber, the request being initiated by the called subscriber, first sending means for sending a query for the calling subscriber telephone book information from the exchange to a server implementing a telephone book information service, the server being connected to the multiple-service network via a

third ISDN interface, in response to the received message, second sending means for sending the calling subscriber telephone book information from the server to the exchange, in response to the received query and third sending means for sending the calling subscriber telephone book information from the exchange to the called subscriber telecommunication terminal using channels reserved for signaling and a signaling protocol comprising a limited amount of information not belonging to the call, in response to the received calling subscriber telephone book information.

As discussed in the present specification, the present invention enables the connection of a server to a digital multiple-service network via an ISDN interface. It is respectfully submitted that the prior art of *Gore et al.*, when viewed or when combined with other references, fails to disclose or suggest all of the elements of any of the presently pending claims. Therefore, the prior art fails to provide the critical and unobvious advantages discussed above.

Gore et al. is directed to process of credit checking in an ISDN environment. The credit check is implemented using a credit-checking database. Credit-check information is transmitted to the ISDN terminal using a D-channel and the results from the credit-checking database is passed back through the network to the sending business.

However, *Gore et al.* fails to teach or suggest a server which is connected to a digital multiple-service network via an ISDN interface (that is, a Basic Rate Interface (BRI) or a Primary Rate Interface (PRI)). Rather, *Gore et al.* discloses a database 280 which is connected to telecommunications network 200 via path 21, which path 21 is a

trunk facility using Signaling System number 7 (SS7) and Transaction Capability Application Part (TCAP), see *Gore et al.*, col. 4, lines 43-46, Fig. 2. It is well known in the art that SS7/TCAP cannot be used over BR1 or PR1 interfaces. Rather, a trunk facility is required for SS7/TCAP. Thus, at least the above identified portions of claims 1 and 18 are neither taught nor suggested by *Gore et al.* and Applicants respectfully assert that the rejection of claims 1 and 18 are improper and should be withdrawn.

Additionally, there are at least two significant advantages in utilizing an ISDN interface rather than a trunk facility. First, utilizing an ISDN interface allows any private individual easily and with low costs to provide a service that can be accessed via a public ISDN network. One can simply set up a PC as a server and connect it to the public ISDN network via a conventional ISDN PC card. Since the network would see the PC as just another ISDN subscription, the network/network operator would not have to be aware that there is a service being provided in this particular ISDN subscription (see, e.g., the instant specification, page 8).

Utilizing a trunk facility, on the other hand, would mean that the network operator would have to be involved. Obviously one could not just go into a shop, buy a trunk facility and plug it into a public ISDN network (as one could do in the case of an ISDN interface). Rather, the server (or the database 280 by *Gore et al.*) would have to be a fixed part of the public ISDN network infrastructure. Thus one would have to contact the network operator and enter into a contract involving e.g. leasing the required hardware.

Therefore, it follows that setting up a service which utilizes an ISDN interface is easier and cheaper. This would particularly be beneficial to when the service is being provided by a private individual or a small business. Thus, for at least this reason, Applicants respectfully assert that claims 1 and 18 are not rendered obvious over the disclosure of *Gore et al.*

Second, utilizing an ISDN interface allows the service to be addressed with a standard ISDN subscription number that has been assigned to the ISDN interface. With a trunk facility this is not possible since SS7 signaling is used. As is known in the art, an element connected to the network via SS7 signaling cannot be addressed with a phone number. Again, one would have to contact the network operator for setting up the network so that the network would be aware for the database 280 by *Gore et al.* in order to be able to forward traffic to and from the database 280. Again, this would result in more costs. Thus, for at least this reason, Applicants respectfully assert that claims 1 and 18 are not rendered obvious over the disclosure of *Gore et al.*

Furthermore, it should be noted that the trunk facility by *Gore et al.* cannot simply be replaced with an ISDN interface. SS7/TCAP used by *Gore et al.* requires a trunk facility. On the other hand, SS7/TCAP are required in the arrangement by *Gore et al.* for accessing the database 280. Thus, for at least this reason, Applicants respectfully assert that claims 1 and 18 are not rendered obvious over the disclosure of *Gore et al.*

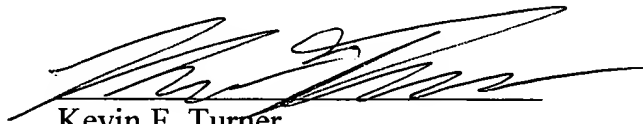
The above-discussed deficiencies are also not cured by the addition of *Wrede et al.*, *European Telecommunication Standards Institute Reference (February 1996)*,

European Telecommunication Standards Institute Reference (October 1991), *Newton's Telecom Dictionary (March 1998)*, *Boivie and Masuda*, in the other rejections. Even if these references were accepted to disclose what the Office has alleged, which Applicants do not admit, they do not teach or suggest the elements not taught by *Gore et al.*, as discussed above. Similarly, claims 2-7, 10-12, 16, 19-24, 27-29 and 33, which depend from claims 1 and 18, should be allowed for at least their dependence on those independent claims.

To conclude, Applicants respectfully request the allowance of claims 1-7, 10-12, 16, 18-24, 27-29 and 33, and request that the application be allowed to pass to issue. If for any reason the Examiner determines that the application is not now in condition for allowance, it is respectfully requested that the Examiner contact, by telephone, the applicant's undersigned attorney at the indicated telephone number to arrange for an interview to expedite the disposition of this application.

In the event this paper is not being timely filed, the applicants respectfully petition for an appropriate extension of time. Any fees for such an extension together with any additional fees may be charged to Counsel's Deposit Account 50-2222.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Kevin F. Turner', is written over a horizontal line.

Kevin F. Turner
Registration No. 43,437

Customer No. 32294
SQUIRE, SANDERS & DEMPSEY LLP
14TH Floor
8000 Towers Crescent Drive
Tysons Corner, Virginia 22182-2700
Telephone: 703-720-7800
Fax: 703-720-7802

KFT:lls